

## **REMARKS**

### **I. Introduction**

With the cancellation of claim 73 herein without prejudice, claims 1 to 59, 61, 62 and 64 to 72 are pending in the present application. It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claims 49 to 54, 56 to 59, 66 and 68 to 72 Under 35 U.S.C. § 102(e)**

Claims 49 to 54, 56 to 59, 66 and 68 to 72 were finally rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,366,206 (“Ishikawa et al.”). Applicant respectfully submits that Ishikawa et al. do not anticipate claims 49 to 54, 56 to 59, 66 and 68 to 72 for the following reasons.

Claim 49 relates a medical label system. Claim 49 recites that the medical label system includes at least one integrated circuit, wherein the integrated circuit uniquely identifies a medical product the label is attached to by transmitting a radio frequency identifier (RFID) for the medical product in response to an RF signal. Claim 49 further recites that medical label system includes a computer system including a set of instructions capable of being executed by a processor to receive the RFID and to track a location of the medical product based on the RFID.

Claim 49 has been amended to recite that the medical label system includes a plurality of sensors configured to generate the RF signal. Claim 49 has further been amended to include the limitations of claim 73. Specifically, claim 49 has been amended to recite that the plurality of sensors comprises at least a first sensor having a first location and a second sensor having a second location, and that the computer system is configured to associate in a memory the medical product with the first location upon sensing of the RFID of the medical product by the first sensor and to associate in the memory the medical product with the second location upon sensing of the RFID of the medical product by the second sensor. Support for these amendments can be found, for example, in the Specification at p. 10, lines 2 to 16. Claim 73 was not rejected based upon Ishikawa et al. Therefore, Applicant respectfully submits that claim 49, amended to include all of the limitations of claim 73, is patentable over Ishikawa et al.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor*

Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth below, it is respectfully submitted that Ishikawa et al. do not disclose, or even suggest, all of the limitations of claim 49. Therefore, withdrawal of the 35 U.S.C. § 102(e) rejection and allowance of claim 49 are respectfully requested.

As for claims 50 to 54, 56 to 59, 66 and 68 to 72, which ultimately depend from claim 49 and therefore include all of the limitations of claim 49, it is respectfully submitted that Ishikawa et al. do not anticipate these dependent claims for at least the same reasons provided above in support of the patentability of claim 49. Therefore, withdrawal of the 35 U.S.C. § 102(e) rejection and allowance of claims 50 to 54, 56 to 59, 66 and 68 to 72 are respectfully requested.

### **III. Rejection of Claims 49 to 59, 61, 62, 66 and 68 to 73 Under 35 U.S.C. § 103(a)**

Claims 49 to 59, 61, 62, 66 and 68 to 73 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Ishikawa et al. and U.S. Patent No. 6,589,170 ("Flach et al."). Applicant respectfully submits that the combination of Ishikawa et al. and Flach et al. does not render unpatentable the present claims for the following reasons.

As indicated above, claim 73 has been canceled thus rendering the rejection of this claim moot.

Ishikawa et al. purportedly relate to a method and apparatus for attaching tags to medical and non-medical devices. Ishikawa et al. state that transponder 15 may be used to tag any medical product or device, or non-medical products or devices. See col. 8, lines 26 to 29. Ishikawa et al. further state that before closing the patient's body at the site of the surgery, the site may be scanned with the monitoring unit 17 and that if a sponge ball transponder 15 responds the sponge may be located and removed. See col. 8, lines 32 to 35. Ishikawa et al. further state that the instruments may be scanned before surgery to generate an inventory and that at the end of the surgery the surgical suite may be scanned to account positively for all items in the inventory. See col. 8, lines 37 to 41.

Nowhere do Ishikawa et al. disclose, or even suggest, a computer system including a set of instructions capable of being executed by a processor to receive the RFID and to track a location of the medical product based on the RFID, as recited in claim 49. Ishikawa et al. merely disclose scanning the medical instruments before surgery to generate an inventory and scanning the entire surgical suite to account positively for all items in the

inventory after the surgery. As can be seen in Figure 3, the computer system of the present invention uses *multiple sensors* and a location field 180 to track the location, e.g., the garbage, the main table, etc., of the medical product in question, not just to account for all medical product in inventory at the end of the surgical procedure as Ishikawa et al. disclose.

The Office Action points to col. 8, lines 26 to 41 and col. 10, lines 20 to 48 and alleges that Ishikawa et al. disclose tracking of a medical product. However, these references merely disclose the sensing of a product using a single sensor so as to assure that such product is not left inside a patient. Applicant respectfully submits that scanning with a single sensor is not the same as tracking. The surgeon may be tracking the location of the device by originally checking in the item and noting the location of the item and then scanning the patient at the end of surgery to once again note the location of the device. However, claim 49 recites that the computer system, not the doctor, tracks the location of the medical product. Ishikawa et al. do not disclose a computer system which in any way tracks a location of a medical product.

Notwithstanding the above, claim 49 has been amended to recite that the medical label system includes a plurality of sensors configured to generate the RF signal. Ishikawa et al. state that a scanner 173 is operable for causing the identifying data of the various items in the operating room to be emitted by corresponding transponders 15. See col. 10, lines 23 to 25. The scanner 173 is stated to be used to compare items input into the operating room with those being removed from the operating room. See col. 10, lines 25 to 29. Nowhere, however, do Ishikawa et al. disclose, or even suggest, a plurality of sensors configured to generate a RF signal, let alone a computer system which associates a position of the label with a position of the sensors, as recited in amended claim 49.

Flach et al. purportedly relate to a medical telemetry system with cellular reception of patient data. Flach et al. do not remedy the above noted deficiencies of Ishikawa et al. Consistently, Flach et al. are not relied upon to remedy the above noted deficiencies of Ishikawa et al. Flach et al. state that each VCELL transmits a low power unmodulated signal to each remote telemeter 102, which measures the signal strengths of the low power transmission of the various VCELLs and estimates the location of a patient based on the signal strength. See col. 14, lines 3 to 21. Therefore, the system of Flach et al. does not include a computer system configured to associate a position of the label with a position of the sensors, as required by claim 49. Flach et al. discloses estimating a location based on signal strength of the low power unmodulated signal not based on the location of the sensor

itself. Therefore, the combination of Ishikawa et al. and Flach et al. does not disclose all of the limitations of claim 49.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As stated above, the combination of Ishikawa et al. and Flach et al. does not disclose, or even suggest, a plurality of sensors configured to generate a RF signal, let alone a computer system configured to associate a position of the label with a position of the sensors, as required by claim 49. Therefore, the combination of Ishikawa et al. and Flach et al. does not render obvious claim 49. Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of claim 49 are respectfully requested.

Moreover, it is respectfully submitted that the cases of *In re Fine*, *supra*, and *In re Jones*, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions that it would have been obvious to modify or combine references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of *In re Fine* stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

**Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

*In re Fine*, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of *In re Jones* stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

**Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].**

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. The Office Action's allegation that it would have been obvious to one of ordinary skill in the art to "have provided the Ishikawa et al system with a computer control system to monitor and store the location of one or more of the RFID tags in a prescribed tracking area to allow a user to promptly identify the location of a medical product in a hospital setting in view of the teaching of Flach et al." is completely unsupported. None of the patents or publications relied upon mention or refer to the motivation alleged in the Office Action for making the proposed combination. As indicated above, Ishikawa et al. merely disclose using a RF scanner to generate an inventory of instruments before surgery and to compare items input into the operating room with those being removed from the operating room. See col. 8, lines 37 to 41 and col. 10, lines 25 to 29. The Office Action admits that Ishikawa et al. does not disclose a tracking system as disclosed by applicant. Further, Flach et al. provides no suggestion or motivation to use multiple sensors configured to generate an RF signal to track a RF label including an integrated circuit.

Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation, outside of Applicant's application, for modifying or combining the references to provide the claimed subject matter. Merely stating that it would have been obvious to have used the computer system of Flach et al. to track the location of the Ishikawa et al. RFID tags does not provide sufficient motivation absent a teaching or suggestion of such a need.

The Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a “technologically simple concept” — which is not the case here — there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

In view of all of the foregoing, it is respectfully submitted that the combination of Ishikawa et al. and Flach et al. does not render obvious claim 49. Therefore, withdrawal of the 35 U.S.C. §103(a) rejection and allowance of claim 49 are respectfully requested.

Claims 50 to 59, 61, 62, 66 and 68 to 72 ultimately depend from claim 49 and therefore include all of the limitations of claim 49. As more fully set forth above, it is respectfully submitted that the combination of Ishikawa et al. and Flach et al. does not disclose, or even suggest, all of the limitations of claim 49, from which claims 50 to 59, 61, 62, 66 and 68 to 72 depend. Therefore, it is respectfully submitted that the combination of Ishikawa et al. and Flach et al. does not render unpatentable these dependent claims for at least the same reasons provided above in support of the patentability of claim 1. In re Fine, supra (any dependent claim that depends from a non-obvious independent claim is non-obvious).

#### **IV. Rejection of Claim 67 Under 35 U.S.C. § 103(a)**

Claim 67 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Ishikawa et al., Flach et al. and U.S. Patent No. 6,313,747 (“Imaichi et al.”).

Applicant respectfully submits that the combination of Ishikawa et al., Flach et al. and Imaichi et al. does not render unpatentable claim 67 for the following reasons.

Claim 67 depends from claim 49 and therefore includes all of the limitations of claim 49. Imaichi et al. purportedly relate to a resonant tag including an insulating thin film and coiled circuits made of a metal foil. Imaichi et al. do not remedy, nor are Imaichi et al. relied upon for remedying, the above detailed deficiencies of Ishikawa et al. and Flach et al. Therefore, the combination of Ishikawa et al., Flach et al. and Imaichi et al. does not disclose, or even suggest, a computer system including a set of instructions capable of being executed by a processor to receive the RFID and to track a location of the medical product based on the RFID, as recited in claim 49. Further, the combination of Ishikawa et al., Flach et al. and Imaichi et al. does not disclose a plurality of sensors configured to generate a RF signal, let alone a computer system which associates a position of the label with a position of the sensors, as required by claim 49. Therefore, the combination of Ishikawa et al., Flach et al. and Imaichi et al. does not render obvious claim 67. Accordingly, withdrawal of the 35 U.S.C. § 103 (a) rejection and allowance of claim 67 are respectfully requested.

**V. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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Dated: July 25, 2005

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